

PATENT


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial #: 10/034,478
Applicants: Chad Gross, et al.
Filed: 28 December 2001
Title: On-line System and Method for Managing Health Care Benefits

Group Art: 2174
Examiner: Pitaro, Ryan F.
Docket #: 20338-301

CERTIFICATE OF TRANSMISSION

I hereby certify under 37 CFR 1.8 that this correspondence is being transmitted by facsimile to "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22113-1450" via the facsimile number 703-872-9306 on April 5, 2005.


Bonnie Cadwell

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450,
Alexandria, VA 22113-1450

DECLARATION OF PRIOR INVENTION IN THE UNITED STATES
TO OVERCOME ISSUE DATE OF CITED PATENT (37 C.F.R. 1.131)

PURPOSE OF DECLARATION

1. This declaration is to establish completion of the invention in this application in the United States, at a date prior to August 21, 2000, which is the filing date of the provisional application claimed as priority by the prior art:

☒ publication
☐ patent

that was cited by the

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- ☒ Examiner.
☐ Applicant.

2. The person making this declaration is:

- ☐ the inventor(s).
- ☐ only some of the joint inventor(s) (and a suitable excuse is attached for failure of the omitted joint inventor(s) to sign)
- ☒ the party in interest (and a suitable explanation as why it is not possible to produce the declaration of the inventor(s) is attached)
- a. I have been employed by Benesight, Inc. since January 11, 2000.
- b. My job title is Business System Development Manager. As such, I manage the development, testing and ongoing maintenance of the Benesight web site, which embodies the invention described and claimed by the Applicants.
- c. The Applicants (Chad Gross, Jane Severson, Tracy Erickson and Diana Esquivel) were all employees of Benesight in 2001 and were part of our team that conceived and developed the invention described and claimed in the present patent application.
- d. As employees of Benesight, it is my belief that all four of the Applicants were under a duty to assign their patent rights to their employer Benesight, Inc.
- e. The four Applicants no longer work at Benesight and therefore they are not available to sign this declaration.
- f. The first attached document ("The TPA Web Consulting and Development Services for TheTPA.COM Statement of Work") is an agreement that Benesight (formerly known as the TPA) entered into with Zamba to assist with the programming of the production web site. This version of the document was printed on June 6, 2000 and shows that certain milestones had already been met, namely:
- May 18, 2000: the technical architecture was finalized;
- May 26, 2000: the user interface was approved; and
- June 1, 2000: the technical content management platform was finalized.
- Furthermore, this document shows that integration testing would occur from August 7, 2000 through August 15, 2000 so that the software modules would be ready for quality assurance testing by August 15, 2000. August 15, 2000 was also the date by which all production database and web servers had to be complete.

These deadlines were met and the production environment of the web site incorporating the present invention was completed and ready for quality assurance testing by August 15, 2000.

- g. The second attached document ("Development Environment") shows the minutes from a meeting held on August 11, 2000, where the team discussed our commitments to getting the production system in place by August 15, 2000.
- h. The third attached document ("The TAP Online Meeting Minutes: June 12, 2000") shows the minutes from our meeting on June 12, 2000. During this meeting we agreed on a soft launch of the product on September 5, 2000. Because the product was to be launched on September 5th, all production had to be finalized in mid August and then tested.

FACTS AND DOCUMENTARY EVIDENCE

3. To establish the date of completion of the invention of this application, the following attached documents and/or models are submitted as evidence:

Document 1: "The TPA Web Consulting and Development Services for TheTPA.COM Statement of Work"

Document 2: "Development Environment"

Document 3: "The TPA Online Meeting Minutes: June 12, 2000"

From these documents and/or models, it can be seen that the invention in this application was made

- ☐ on _____
- ☒ at least by the date of August 20, 2000, which is a date earlier than the filing date of the provisional application to which the U.S. patent application claims priority.

TIME OF PRESENTATION OF THE DECLARATION

(complete (a), (b) or (c))

- (a) ☒ This declaration is submitted prior to final rejection.
- (b) ☐ This declaration is submitted with the first response after final rejection, and is for the purpose of overcoming a new ground of rejection or requirement made in the final rejection.
- (c) ☐ This declaration is submitted after final rejection. A showing under 37 C.F.R. § 1.116(b) is submitted herewith.

DECLARATION**6. As a person signing below:**

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

SIGNATURE**7. Declarant, on behalf of Benesight, Inc. (Party of Interest)****Name:** Jim Negomir**Signature:** _____**Title:** Business System Development Manager**Date:** April 5, 2005